

### **REMARKS**

This paper responds to the Office Action mailed on August 29, 2006.

Claims 1, 6, 8, 11, 13, 37, and 39 are amended, claims 7, 12, 22-26, and 38 are canceled without prejudice or disclaimer, and no claims are added; as a result, claims 1-2, 4-6, 8-11, 13-15, 27-29, 37, and 39-59 remain pending in this application.

Applicant further informs the Examiner of a co-pending application serial no. 11/456,518, now published as 20060253694A1.

#### **§102 Rejection of the Claims**

Claim 1 was rejected under 35 U.S.C. § 102(b) for anticipation by PCI Special Interest Group "PCI Bus Power Management Interface Specification," December 18, 1998, ("Special").

Applicant has chosen to amend claim 1 to clarify the claim. The amendment specifies that the next node pointer registers are writable. This amendment places claim 1 in a form similar to previously pending claim 7 which was indicated as allowable in the most recent Office Action. Applicant respectfully submits that this amendment also places claim 1 in allowable form. Thus, Applicant respectfully requests consideration and allowance of amended claim 1.

Claims 6 and 10 were rejected under 35 U.S.C. § 102(e) for anticipation by Mitra et al. (U.S. 6,167,472).

Applicant has amended independent claim 6 to incorporate previously pending claim 7 which was indicated to be allowable in the most recent Office Action. Thus, Applicant respectfully submits that amended independent claim 6 is now in allowable form. Also, claim 10 is now in allowable form as it depends directly from amended independent claim 6.

Consideration of the amendment to claim 6 and allowance of claims 6 and 10 is respectfully requested.

Please note that the cancellation of claim 7 further necessitated amendment of claim 8 to correct the dependent of the claim from cancelled claim 7 to amended independent claim 6. Consideration of this amendment and allowance of claim 8 is earnestly requested.

§103 Rejection of the Claims

Claims 1, 2 and 4-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Solomon (U.S. 5,925,134) in view of Sibigtroth (U.S. 4,580,246).

As discussed above with regard to amended independent claim 1, Applicant has amended the claim to specify that the next node pointer registers are writable. Applicant respectfully submits that this amendment places independent claim 1 in a similar form to that of previously pending claim 7 which was indicated as allowable if rewritten into an independent form. Thus, Applicant respectfully submits that this amendment places independent claim 1 in allowable form.

Claims 2 and 4-5 depend directly from allowable amended independent claim 1 and are allowable the same reasons, plus the elements of the claims.

Applicant therefore requests consideration of the amendment to claim 1 and allowance of claims 1-2 and 4-5.

Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitra et al. (U.S. 6,167,472) as applied to claim 6 above, in view of Gafken (U.S. 6,026,016).

Claim 9 depends from amended independent claim 6 discussed above with regard to the Section 102(b) rejections. Thus, Applicant respectfully requests allowance of claim 9.

Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Larsen et al. (U.S. 6,154,819) in view of ("Special").

Claim 11 has been amended to include previously pending claim 12 which was indicated as allowable in the most recent office action if rewritten in independent form. Thus, Applicant respectfully submits that claim 11 is now in allowable form. This amendment and cancellation of claim 12 has necessitated amendment of claim 13 to modify the dependence of claim 13 from claim 12 to claim 11. Thus, Applicant respectfully requests consideration of these amendments and allowance of claims 11 and 13.

Claims 22-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Solomon in view of DeRoo et al. (U.S. 5,764,995). Applicant has chosen to withdraw claims 22-

26 from consideration at this time by canceling the claims. However, Applicant reserves the right to reintroduce these claims at a later date in a continuing or divisional application.

Claims 37 and 40-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Solomon in view of Larsen et al. Applicant has chosen to amend independent claim 37 to include the language of objected to claim 38, which was indicated as allowable if rewritten in independent form. This amendment necessitated cancellation of claim 38 and amendment of claim 39 to modify the dependence of the claim to claim 37. Thus, Applicant respectfully submits that claim 37 is now in allowable form, as well as claims 40-41 which depend therefrom. Consideration of this amendment and allowance of claims 37 and 40-41 is earnestly requested.

Claims 42-59 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Solomon in view of Gafken.

Applicant has chosen to withdraw claims 42-46 from consideration at this time through cancellation of the claims. However, Applicant reserves the right to pursue these claims at a later date in a continuing or divisional application.

With regard to claims 47-51, Applicant respectfully traverses the rejection because the proposed combination of Solomon in view of Gafken fails to teach or suggest the entirety of independent claim 47. For example, the Office Action states that "Solomon does not expressly teach the writing a list of capabilities to nodes in a hardware linked list." Gafken is present to generally show locking of memory cells or registers. However, Gafken fails to cure and is not presented to cure the admitted deficiency of Solomon. Thus, because the combination of Solomon and Gafken admittedly fails to teach "writing a list of capabilities to nodes in a hardware linked list within the computer peripheral during initialization of the computer peripheral," Applicant respectfully requests allowance of claim 47. Applicant further requests allowance of claims 48-51 which depend directly therefrom.

With regard to claims 52-55, Applicant respectfully traverses the rejection because the references, even if combined, fail to teach or suggest “modifying a link within a capabilities linked list in the PCI local bus compliant device.” Although Solomon discusses a capabilities list with regards to power management, there is no mention of modifying the capabilities list. Further, although Gafken discusses locking memory, there is no mention of a capabilities list or of modifying a capabilities list. Thus, the combination of Solomon and Gafken fails to teach or suggest the entirety of independent claim 52.

Thus, Applicant respectfully submits that independent claim 52 and claims 53-55 which depend therefrom are patentable over Solomon and Gafken. Withdrawal of the rejection and allowance of the claims is respectfully requested.

With regard to claims 56-59, Applicant respectfully traverses the rejection. Similar to independent claim 52, independent claim 56 includes “modifying a next node pointer register in a PCI local bus peripheral to indicate the existence of a capability.” Solomon and Gafken fail to teach or suggest modifying a capabilities list. In Solomon, the capabilities list is static. In Gafken, there is no mention of a capabilities list. Although modification of linked lists is well known, modifying of a capabilities list of a PCI local bus peripheral was not known at the time of the presently claimed inventive subject matter. Thus, Applicant respectfully requests withdrawal of the rejection of claims 56-59 and allowance of the claims.

Allowable Subject Matter

Claims 15 and 27-29 were allowed.

Claims 7-8, 12-14 and 38-39 were objected to as being dependent upon a rejected base claim, but were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant has amended independent claim 6 to incorporate claim 7, which is now cancelled. Claim 8 has been amended to depend from amended independent claim 6. Allowance of amended claims 6 and 8 is earnestly requested.

Applicant has amended independent claim 11 to incorporate claim 12, which is now cancelled. Claim 13 has been amended to depend from amended independent claim 11. Allowance of amended claims 11 and 13 is earnestly requested.

Claim 14 actually depends from claim 15 which was allowed in the last office action. Claim 14 was amended in the Office Action response mailed January 31, 2006 to depend from claim 15. Thus, Applicant respectfully submits that claim 14 is allowable. Notification to that effect is earnestly requested.

Applicant has amended independent claim 37 to incorporate claim 38, which is now cancelled. Claim 39 has been amended to depend from amended independent claim 37. Allowance of amended claims 37 and 39 is earnestly requested.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 349-9587 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

A. K. PORTERFIELD

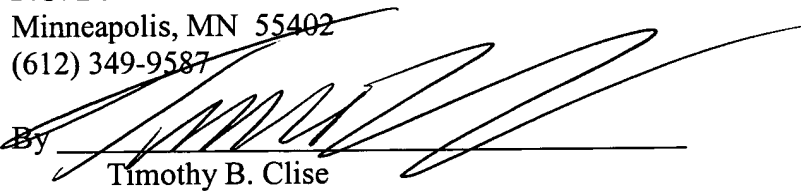
By his Representatives,

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Date

29 Nov '06

By



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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 29 day of November 2006.

Name

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Signature

